

ESTTA Tracking number: **ESTTA710354**

Filing date: **11/23/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Boston Scientific Neuromodulation Corporation
Granted to Date of previous extension	11/22/2015
Address	25155 Rye Canyon Loop Valencia, CA 91355 UNITED STATES
Attorney information	James R. Steffen Faegre Baker Daniels LLP 90 South Seventh Street 2200 Wells Fargo Center Minneapolis, MN 55402 UNITED STATES james.steffen@faegrebd.com, tmmpls@faegrebd.com Phone:612.766.7000

Applicant Information

Application No	86489503	Publication date	05/26/2015
Opposition Filing Date	11/23/2015	Opposition Period Ends	11/22/2015
Applicant	St. Jude Medical, Inc. One St. Jude Medical Drive St. Paul, MN 55117 UNITED STATES		

Goods/Services Affected by Opposition

Class 010. First Use: 0 First Use In Commerce: 0


All goods and services in the class are opposed, namely: Medical devices for deep brain stimulation

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	4313589	Application Date	03/02/2011
Registration Date	04/02/2013	Foreign Priority Date	NONE
Word Mark	INFINION		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 010. First use: First Use: 2011/11/09 First Use In Commerce: 2011/11/09 Medical Leads, namely, Pulse Generator Leads

Attachments	85255606#TMSN.png(bytes) St Jude - INFINITY.pdf(169711 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/James R Steffen/
Name	James R. Steffen
Date	11/23/2015

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Serial No.: 86/489,503
For the Mark: INFINITY
Filed: December 23, 2014
Published: May 26, 2015

BOSTON SCIENTIFIC)	Opposition No. _____
NEUROMODULATION)	
CORPORATION,)	
)	
Opposer,)	
)	
v.)	<u>NOTICE OF OPPOSITION</u>
)	
ST. JUDE MEDICAL, INC.,)	
)	
Applicant.)	
)	

Opposer Boston Scientific Neuromodulation Corporation (“BSNC”) is a Delaware corporation having its principal place of business at 25155 Rye Canyon Loop, Valencia, CA 91355.

BSNC believes that it will be damaged by, and hereby opposes, the registration of the mark in Trademark Application Serial No. 86/489,503.

As grounds of this opposition, it is alleged that:

1. BSNC is the owner of U.S. Trademark Registration No. 4,313,589 for the mark INFINION for use in connection with medical leads, namely pulse generator leads within International Class 10 (the “BSNC Registration”). The BSNC Registration has a

priority date of March 2, 2011, and reflects a date of first use at least as early as November 9, 2011. A true and correct copy of TSDR information for the BSNC Registration is attached hereto as Exhibit A.

2. BSNC has since at least as early 2011 used the INFINION mark in connection with percutaneous leads that are a part of spinal cord stimulator systems.

3. Upon information and belief, applicant is a Minnesota corporation with address at One St. Jude Medical Drive, St. Paul, MN 55117.

4. Applicant is the owner of an intent-to-use application, Serial No. 86/489,503 (the “‘503 Application”), filed December 23, 2014, for the mark INFINITY for use in connection with “medical devices for deep brain stimulation” within International Class 10.

5. Upon information and belief, the “medical devices for deep brain stimulation” in connection with which Applicant is using and/or intends to use the INFINITY mark include pulse generator leads.

6. The priority date of BSNC’s Registration is earlier than the filing date of Applicant’s ‘503 Application, and, upon information and belief, is earlier than any use by Applicant of the mark INFINITY.

7. BSNC’s actual, continuous, and continuing use of the INFINION mark began long prior to the filing of Applicant’s ‘503 Application, and, upon information and belief, long prior to any use by Applicant of the mark INFINITY.

8. The INFINITY Mark claimed in Applicant's '503 Application so resembles BSNC's INFINION mark as to be likely, when used in connection with the goods listed in the '503 Application, to cause confusion, to cause mistake, and/or to deceive. The mark in Applicant's '503 Application cannot be registered consistent with Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

WHEREFORE, BSNC believes that it would be damaged by registration of the mark shown in Applicant's '503 Application, and prays that the '503 Application be rejected, that no registration be issued thereon to Applicant, and that this opposition be sustained in favor of BSNC.

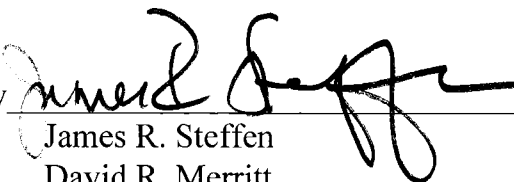
The requisite filing fee of \$300.00 is submitted herewith. If the amount submitted is determined to be incorrect, the Commissioner may charge any additional fees or to credit any over payment to Deposit Account No. 06-0029.

Please address all correspondence to:

James R. Steffen
Faegre Baker Daniels LLP
2200 Wells Fargo Center
90 South Seventh Street
Minneapolis, MN 55402

Dated: November 23, 2015

FAEGRE BAKER DANIELS LLP

By 

James R. Steffen
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**Attorneys for Boston Scientific
Neuromodulation Corporation**


US.103405445.01

CERTIFICATE OF SERVICE

I, Sarah M. House, do hereby certify that I cause to be delivered by United States Mail a true and correct copy of the above and foregoing document to the following addressee on this 23d day of November, 2015:

Steven M. Mitchell
St. Jude Medical
645 Almanor Avenue
Sunnyvale, CA 94085

Steven M. Mitchell
Pacesetter, Inc.
15900 Valley View Ct
Sylmar, CA 91342-3585



Sarah M. House

US.103405445.01

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Mark: INFINION

INFINION

US Serial Number: 85255606

Application Filing Date:

Mar. 02, 2011

US Registration Number: 4313589

Registration Date:

Apr. 02, 2013

Register:

Principal

Mark Type:

Trademark

Status:

Registered. The registration date is used to determine when post-registration maintenance documents are due.

Status Date:

Apr. 02, 2013

Publication Date: Jul. 19, 2011

Notice of Allowance Date:

Sep. 13, 2011

Mark Information

Mark Literal Elements:

INFINION

Standard Character Claim:

Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type:

4 - STANDARD CHARACTER MARK

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks "*" identify additional (new) wording in the goods/services.

For:

Medical Leads, namely, Pulse Generator Leads

International Class(es): 010 - Primary Class

U.S Class(es):

026, 039, 044

Class Status:

ACTIVE

Basis:

1(a)

First Use: Nov. 09, 2011

Use in Commerce:

Nov. 09, 2011

Basis Information (Case Level)

Filed Use: No

Currently Use: Yes

Amended Use: No

Filed ITU: Yes

Currently ITU: No

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: No

Currently 44E: No

Amended 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name:

Boston Scientific Neuromodulation Corporation

Owner Address:

25155 Rye Canyon Loop
Valencia, CALIFORNIA 91355
UNITED STATES

Legal Entity Type: CORPORATION

**State or Country Where
Organized:**

DELAWARE

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Luke Dohmen

**Attorney Primary Email
Address:** trademarks@bsci.com

**Attorney Email
Authorized:**

Yes

Correspondent

**Correspondent
Name/Address:**

Luke Dohmen
Boston Scientific Corporation
One Scimed Place
Minneapolis, MINNESOTA 55311
UNITED STATES

Phone: 763-494-1700

Correspondent e-mail: trademarks@bsci.com michelle.anderson@bsci.com
om

**Correspondent e-mail
Authorized:**

Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Jan. 29, 2015	ATTORNEY REVOKED AND/OR APPOINTED	
Jan. 29, 2015	TEAS REVOKE/APPOINT ATTORNEY RECEIVED	
Jan. 29, 2015	ATTORNEY REVOKED AND/OR APPOINTED	
Jan. 29, 2015	TEAS REVOKE/APPOINT ATTORNEY RECEIVED	
Apr. 02, 2013	REGISTERED-PRINCIPAL REGISTER	
Feb. 28, 2013	NOTICE OF ACCEPTANCE OF STATEMENT OF USE E-MAILED	
Feb. 27, 2013	LAW OFFICE REGISTRATION REVIEW COMPLETED	70884
Feb. 27, 2013	ASSIGNED TO LIE	70884
Feb. 15, 2013	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
Feb. 12, 2013	STATEMENT OF USE PROCESSING COMPLETE	66230
Feb. 08, 2013	USE AMENDMENT FILED	66230
Feb. 08, 2013	TEAS STATEMENT OF USE RECEIVED	
Sep. 12, 2012	NOTICE OF APPROVAL OF EXTENSION REQUEST E-MAILED	
Sep. 11, 2012	EXTENSION 2 GRANTED	66230
Sep. 07, 2012	EXTENSION 2 FILED	66230
Sep. 07, 2012	TEAS EXTENSION RECEIVED	
Mar. 30, 2012	ATTORNEY REVOKED AND/OR APPOINTED	
Mar. 30, 2012	TEAS REVOKE/APPOINT ATTORNEY RECEIVED	
Mar. 17, 2012	NOTICE OF APPROVAL OF EXTENSION REQUEST E-MAILED	
Mar. 16, 2012	EXTENSION 1 GRANTED	66230
Feb. 22, 2012	EXTENSION 1 FILED	66230
Mar. 16, 2012	CASE ASSIGNED TO INTENT TO USE PARALEGAL	66230
Feb. 22, 2012	TEAS EXTENSION RECEIVED	
Sep. 13, 2011	NOA E-MAILED - SOU REQUIRED FROM APPLICANT	
Jul. 19, 2011	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Jul. 19, 2011	PUBLISHED FOR OPPOSITION	

Jun. 02, 2011	APPROVED FOR PUB - PRINCIPAL REGISTER
Jun. 02, 2011	ASSIGNED TO EXAMINER
Mar. 08, 2011	NOTICE OF PSEUDO MARK MAILED
Mar. 06, 2011	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM
Mar. 05, 2011	NEW APPLICATION ENTERED IN TRAM

83706

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location:

Feb. 27, 2013